



LOC  
03C0  
10-19-95

HW

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Sorge et al.

Serial No.: 08/529,767

Art Unit: N/A

Filed: September 18, 1995

Examiner: N/A

For: NOVEL POLYMERASE  
COMPOSITIONS AND USES  
THEREOF

Attorney Docket No.:  
8142-108-999

**RESPONSE TO NOTICE TO FILE MISSING PARTS FILING DATE GRANTED/  
NOTICE TO COMPLY WITH SEQUENCE LISTING REQUIREMENTS**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

Applicants are writing in response to the Notice to File Missing Parts mailed October 19, 1995. Applicants submit that the Notice to File Missing Parts has been sent in error. The Notice to File Missing Parts indicates that (1) the declaration is missing, (2) the filing fee is missing, and (3) the sequence listing rules have not been complied with. Applicants respectfully submit that all three of these requirements have been met.

The subject application was filed as a Rule 60 Divisional on September 9, 1995. A copy of the filing request is included with this communication. As can be seen on the enclosed form: (1) the application was filed under Rule 60 and does not require a new declaration; (2) the PTO was authorized

**EXPRESS MAIL CERTIFICATION**

"Express Mail" label No. TB 666 914 171 Date of Deposit October 26, 1995.  
I hereby certify that this paper or fee is being deposited with the United States Postal Service  
"Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and is  
addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.

E. Marucut

(Type or print name of person mailing paper or fee)  
*Marucut*  
(Signature of person mailing paper or fee)

PEMP-45542.1

to charge deposit account no. 16-1150 (Box 4); and (3) the sequence listing and computer-readable form of the sequence listing from the parent application is to be used (Box 14).

In view of the above facts, it is apparent that the Notice to File Missing Parts was sent in error. Accordingly, a filing receipt should be mailed promptly. The PTO is invited to call the undersigned attorney if any additional questions remain.

Respectfully submitted,

**PENNIE & EDMONDS**

Dated: 10/26/95

*Albert P. Halluin* Reg. No. 37,218  
Albert P. Halluin 25,227  
(Reg. No.)

1155 Avenue of the Americas  
New York, N.Y. 10036-2711  
(415) 854-3660

**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such disclosure as set forth in 37 CFR 1.821 - 1.825 for the following reason(s):

1. This application clearly fails to comply with the requirements of 37 CFR 1.821 - 1.825. Applicant's attention is directed to these regulations, published at 1114 OG 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.
2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 CFR 1.821(c).
3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e).
4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 CFR 1.822 and/or 1.823, as indicated on the attached marked-up copy of the "Raw Sequence Listing."
5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A substitute computer readable form must be submitted as required by 37 CFR 1.825(d).
6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 CFR 1.821(e).
7. Other: \_\_\_\_\_

**Applicant must provide:**

- An initial or substitute computer readable form (CRF) copy of the "Sequence Listing"
- An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification
- A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d)

For questions regarding compliance with these requirements, please contact:

For Rules Interpretation, call (703) 308-1123  
For CRF submission help, call (703) 308-4212  
For PatentIn software help, call (703) 308-6856

**Please return a copy of this notice with your response.**



PENNIE & EDMONDS DOCKET NO. 8142-108-999

THE UNITED STATES PATENT AND TRADEMARK OFFICE

**COPY**

Anticipated Classification of this application:

Class (subclass) 424

Prior application:

Examiner E. Campbell

Art Unit 1807

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

This is a request for filing a  continuation  divisional application under 37 CFR § 1.60, of pending prior application serial no. 08/197,791 filed on February 16, 1994.

of Joseph A. Sorge and Rebecca L. Mullinax  
(inventor(s) currently of record in prior application)

for NOVEL POLYMERASE COMPOSITIONS AND USES THEREOF  
(title of invention)

1.  Enclosed is a copy of the prior application, including the oath or declaration, as originally filed. I hereby verify that the enclosed is a true copy of the prior application.
2.  Enclosed is a copy of the prior application, including the oath or declaration as originally filed and an affidavit or declaration verifying it as a true copy.
3.  The filing fee is calculated below:

**CLAIMS AS FILED IN THE PRIOR APPLICATION, LESS ANY CLAIMS  
CANCELLED BY AMENDMENT BELOW**

EXPRESS MAIL CERTIFICATION

\*Express Mail\* label No. TB 666 913 929

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.

E. Marcut

*Erin Marcut*

# COPY

PENNIE & EDMONDS DOCKET NO. 8142-108-999

PATENT APPLICATION FEE VALUE

TYPE	NO. FILED	LESS	EXTRA	EXTRA RATE	FEE
Total Claims	16	-20	0	\$22.00 each	0.00
Independent	1	-3	0	\$76.00 each	0.00
			Basic Fee		730.00
			Multiple Dependency Fee If Applicable (\$240.00)		
			Total		730.00
			50% Reduction for Independent Inventor, Nonprofit Organization or Small Business Concern		
					- 365.00
			Total Filing Fee		\$ 365.00

- 4.  Please charge the required fee to Pennie & Edmonds Deposit Account No. 16-1150. A copy of this sheet is enclosed.
- 5.  Cancel in this application original claims 17-32 of the prior application before calculating the filing fee (At least one original independent claim must be retained for filing purposes).
- 6.  Amend the specification by inserting before the first line the following sentence: This is a  divisional of application serial no. 08/197,791 filed February 16, 1994 which is a CIP of application serial no. 08/164,290 filed December 8, 1993.
- 7a.  Transfer the drawings from the prior application to this application and abandon the prior application as of the filing date accorded this application. A duplicate copy of this sheet is enclosed for filing in the prior application file.
- 7b.  New formal drawings are enclosed.
- 7c.  Informal drawings are enclosed.
- 8a.  Priority of application serial no. 08/164,290 filed December 8, 1993 is claimed under 35 U.S.C. §120.
- 8b.  The certified copy has been filed in prior application serial no. , filed .
- 9.  The prior application is assigned of record to STRATAGENE.
- 10a.  The Power of Attorney appears in the original papers in the prior application serial no. 08/197,791 filed February 16, 1994.
- 10b.  Since the Power of Attorney does not appear in the original papers, a copy of the Power in prior application serial no. , filed is enclosed.
- 11.  A preliminary amendment is enclosed.

PENNIE & EDMONDS DOCKET NO. 8142-108-999

12.  A preliminary amendment will be filed after issuance of the filing receipt.
- 13a.  Small entity status was established in prior application serial no. 08/197,791 filed February 16, 1994 and is still proper and desired.
- 13b.  A verified statement claiming small entity status is enclosed.
14.  This application contains nucleic acid and/or amino acid sequences required to be disclosed in a Sequence Listing under 37 CFR §§1.821-1.825. It is requested that the Sequence Listing in computer readable form from prior application serial no. 08/197,791 filed on February 16, 1994 be made a part of the present application as provided for by 37 C.F.R. §1.821(e). The sequences disclosed therein are the same as the sequences disclosed in this application. A copy of the paper Sequence Listing from serial no. 08/197,791 is enclosed.
15.  The undersigned states, under 37 C.F.R. §1.821(f), that the content of the enclosed paper Sequence Listing from serial no. 08/197,791 is the same as the content of the computer readable form submitted in application serial no. 08/197,791.
16.  Additional enclosures or instructions.
17.  Address all future communications to PENNIE & EDMONDS, 1155 Avenue of the Americas, New York, New York 10036-2711.

The undersigned declares further that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

9/18/95  
(date)

*COPY*  
Albert P. Halluin (signature) re, 34,298 fo-  
25,227 (Reg No.)

Name and address of signator:

Inventor(s)

Scott R. Bortner

Assignee of complete interest

2730 Sand Hill Road, #300

Attorney or agent of record

Menlo Park, CA 94025

XXX Filed under rule 34(a)

Tel. No. (212) 790-9090

PENNIE & EDMONDS



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
--------------------	-------------	-----------------------	------------------------

08/529, 767 09/18/95 SORGE

J 8142-108-999

0272/1019

PENNIE & EDMONDS  
1155 AVENUE OF THE AMERICAS  
NEW YORK NY 10036-2711

0000

DATE MAILED: 10/19/95

**NOTICE TO FILE MISSING PARTS OF APPLICATION  
FILING DATE GRANTED**

An Application Number and Filing Date have been assigned to this application. However, the items indicated below are missing. The required items and fees identified below must be timely submitted **ALONG WITH THE PAYMENT OF A SURCHARGE** for items 1 and 3-6 only of \$ 130 for large entities or \$ \_\_\_\_\_ for small entities who have filed a verified statement claiming such status. The surcharge is set forth in 37 CFR 1.16(e).

If all required items on this form are filed within the period set below, the total amount owed by applicant as a  large entity,  small entity (verified statement filed), is \$ 195.

Applicant is given ONE MONTH FROM THE DATE OF THIS LETTER, OR TWO MONTHS FROM THE FILING DATE of this application, WHICHEVER IS LATER, within which to file all required items and pay any fees required above to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

1.  The statutory basic filing fee is:  missing  insufficient. Applicant as a  large entity  small entity, must submit \$ 130 to complete the basic filing fee.

2.  Additional claim fees of \$ \_\_\_\_\_ as a  large entity,  small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due.

3.  The oath or declaration:

- is missing.  
 does not cover the newly submitted items.

An oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date is required.

4.  The oath or declaration does not identify the application to which it applies. An oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.

5.  The signature(s) to the oath or declaration is/are:  missing;  by a person other than the inventor or a person qualified under 37 CFR 1.42, 1.43, or 1.47. A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.

6.  The signature of the following joint inventor(s) is missing from the oath or declaration:

\_\_\_\_\_  
An oath or declaration listing the names of all inventors and signed by the omitted inventor(s), identifying this application by the above Application Number and Filing Date, is required.

7.  The application was filed in a language other than English. Applicant must file a verified English translation of the application and a fee of \$ \_\_\_\_\_ under 37 CFR 1.17(k), unless this fee has already been paid.

8.  A \$ \_\_\_\_\_ processing fee is required since your check was returned without payment. (37 CFR 1.21(m)).

9.  Your filing receipt was mailed in error because your check was returned without payment.

10.  The application does not comply with the Sequence Rules. See attached Notice to Comply with Sequence Rules 37 CFR 1.821-1.825.

11.  Other.

Direct the response to Box Missing Part and refer any questions to the Customer Service Center at (703) 308-1202.

**A copy of this notice MUST be returned with the response.**